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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,661	01/10/2001	Thomas Magid	9726-2	7492
30951	7590	05/03/2005	EXAMINER	
NASH & TITUS, LLC 21402 UNISON RD MIDDLEBURG, VA 20117			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/757,661

Applicant(s)

MAGID, THOMAS

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13 and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, and 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant's "Amendment" filed on January 28, 2005 has been considered with the following effect.

Applicant's response to claim 1 has not overcome the Examiner's rejection of such claim under 35 USC 101. Claim 1 is rejected under 35 U.S.C. 101 because it fails to recite **computer executable** instructions. The claims are directed to computer-**readable** medium. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

Applicant's response by virtue of amendment to claims 1-4, 6-13, and 15-34 has overcome the Examiner's rejection of such claim under 35 USC 112, second paragraph.

Claims 1-4, 6-10, 19-21, 26-27, 31 and 34 are amended. Claims 5 and 14 are cancelled. Claims 1-4, 6-13, and 15-34 are pending in this application.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is rejected under 35 U.S.C. 101 because it fails to recite **computer executable** instructions. The claims are directed to computer-**readable** medium. Giving the term its broadest reasonable interpretation, the

Art Unit: 3627

claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 6-13, and 15-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,933,498 to Schneck et al.**

Regarding claims 1, 10, and 19, Schneck discloses a computerized system, method and computer program product comprising:

- a computerized central network core site comprising at least one computer readable medium through which (col. 10, lines 20-26; col. 15, lines 1-8; col. 15, lines 44-50);
- a seller (data distributor) presenting a first level of information disclosure of the patent or trade secret relating to a product or method (col. 1, lines 32-35) to a prospective purchaser via system and requesting a first response, the first response comprising a fulfillment a fulfillment of a first demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48):

Art Unit: 3627

- the purchaser fulfilling the first demand via the system (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- the seller presenting a second level of disclosure that is more confidential and more secure than the first level of disclosures relating to said product or method that is more confidential and is more secure than the first level of disclosure to the purchaser and requests a second response, the second response comprising a fulfillment of a second demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48)
- the purchaser fulfilling the second demand (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- and wherein at least one level of information disclosure comprises an amount of description of said product or method (col. 6, lines 51-58; col. 13, lines 7-9) and the seller and purchaser optionally entering into a contract (see at least col. 22, lines 5-61)

Regarding claims 2, 6, 8-9, 11, 15, 17-18, 20, and 22, 24, Schneck discloses seller presents additional levels of disclosure; the successive level of presenting has associated therewith an increasing level of confidentiality and security; and wherein each level of the presenting comprises revealing additional information relating to the patent or trade secret; peripheral services relating to the marketing or exchange of patents or trade secrets offered (see at least col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claims 3-4 and 12-13, the recitations that “the contract is a licensing agreement” and “the contract is an assignment of rights”, such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “contract” already disclosed by Schneck.

Regarding claims 7 and 16, the recitation that “the demands comprise compensation, comprising one or more of money, certification authentication or agreements”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “demand” already disclosed by Schneck.

Regarding claims 21, 23, 25-30, and 32-33, Schneck discloses the first and second responses are requested by the purchaser and comprise fulfillment of a first and second demand by the seller, and the seller fulfills the first and second demands; the purchaser also requests a response from the seller comprising fulfillment of a demand by the seller prior to presentation of each level of disclosure; first level of disclosure is unsecure; one or more additional steps of presenting levels of disclosure and requesting responses by the seller and purchaser and fulfilling the responses (see at least col. 9, lines 55-59; col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claim 31, the recitations that “patent or trade secret is for an invention to a tangible item or for a method” and “the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times”, such

Art Unit: 3627

recitations are given little patentably weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "patent or trade secret" and "contract" already disclosed by Schneck.

Regarding claim 34, the recitation that "the computerized system is the Internet", such recitation is given little patentably weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "network" already disclosed by Schneck.

### ***Response to Arguments***

Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive.

Applicant's remark that in Schneck "intellectual property as it is used in Schneck, is used loosely to refer to the physical data or product and not the actual patent or trade secret". Furthermore, Applicant's remark that that "the protection offered by Schneck of the data itself is clearly described in Schneck as being different than the protection of information relating to the product, such as patents or trade secret, and termed by Schneck as protections at law".

The Examiner does not concur. Schneck discloses that the invention is used to protect intellectual property by controlling access to that property (col. 34, lines 29-30). Schneck further discloses a system of distributing data such as intellectual property that provides controlled access to the data (col. 10, lines 27-30). Furthermore, Schneck discloses that intellectual property can be embodied in forms which can be copied from the owner while the owner still retains the original (col. 1, lines 33-35). Moreover, the

Art Unit: 3627

Examiner notes that "intellectual property" is known by definition as "creative ideas and expressions of the human mind that have commercial value and receive the legal protection of a property right. The major legal mechanisms for protecting rights are copyrights, patents, and trademarks" (see definition of "intellectual property": Glossary of Intellectual property terms, August 17, 200).

Such controlling access to data such as intellectual property and the definition of intellectual property are considered the actual patent and trade secrets.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



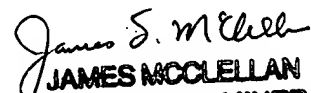
Art Unit: 3627

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
April 26, 2005

  
**JAMES MCCLELLAN**  
**PRIMARY EXAMINER**